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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,132	02/08/2000	Kiyoshi Iseki	11197/1	2161

26646 7590 05/20/2002

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

[REDACTED] EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
1772	12

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/500,132	ISEKI ET AL.	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 March 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) 5-19 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 112 rejections of claims 1-4 of record in Paper #8, Pages 2 and 3, Paragraphs #3 and #5 have been withdrawn due to the Applicant's amendment in Paper #11.

Rejections Repeated

2. The 35 U.S.C. 102 rejection of claims 1 and 2 as anticipated by Matsuda et al. is repeated for the reasons previously of record in Paper #8, Page 3, Paragraph #7.
3. The 35 U.S.C. 102/103 rejection of claims 3 and 4 as anticipated by or, in the alternative, as obvious over Matsuda et al. is repeated for the reasons previously of record in Paper #8, Pages 4 and 5, Paragraph #9.

Response to Arguments

4. Applicant's arguments filed March 27, 2002 have been fully considered but they are not persuasive. Applicant argues that Matsuda "does not in any way teach or suggest that the ratio of the maximum thickness of the inorganic oxide layer to the minimum thickness of the inorganic oxide layer in the claimed transparent plastic film is 1.5 or less." However, it was clearly pointed out that Matsuda discloses an inorganic oxide layer (col.2, lines 42-45) and a film having a thickness of "preferably 50 to 8000 angstroms....more preferably 70 to 5000 angstroms and most preferably 100 to 3000 angstroms". It would inherently appear from the disclosure of

Matsuda that the ratio of the maximum thickness to the minimum thickness of the inorganic oxide layer would be 1.5 or less. In response to Applicant's argument that "Matsuda provides no disclosure with respect to ensuring inorganic oxide layer thickness uniformity or how the thickness of such layer affects the physical properties of the resultant film," the limitations on which Applicant's relies (i.e., ...ensuring inorganic oxide layer....affects the physical properties of the resultant film) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Regarding claim 2 and the recitation "a difference between a maximum value and a minimum value of a composition of one component of composite oxide matter is within 20 wt%", Applicant states that, "the passages cited by the Examiner merely disclosed preferred weight percentages of components in a composite oxide in a thin layer used for gas barrier properties. This passage does not disclose anything about the uniformity of the composition of the inorganic oxide layer when it contains a mixture of two or more inorganic oxide materials." However, such is not being claimed. There is no recitation in claim 2 regarding "the uniformity of the composition" or "when it contains a mixture," etc. The passage cited merely implies that the difference between a maximum wt% of and minimum wt% of one component of the composite oxide could inherently fall within 20 wt%. Regarding claims 3 and 4, Applicant states that "the Examiner's mere assertion that because "similar materials" are used in Matsuda, is inadequate to establish that the static electricity range of from -10kV to +10kV as recited in claim 3 and the variation in thickness of the inorganic oxide film of +20% as recited in claim 4 *necessarily* flow from the disclosure of Matsuda." By this statement, and the statements preceding in Applicant's remarks, Applicant appears to acknowledge the fact that one

skilled in the art would conclude that because “similar materials” are used in Matsuda is adequate enough to establish that the static electricity range of from -10kV to +10kV as recited in claim 3 and the variation in thickness of the inorganic oxide film of \pm as recite in claim 4 necessarily flow from the disclosure of Matsuda.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone
Examiner
Art Unit 1772

May 8, 2002


HAROLD PYON
SUPERVISORY PATENT EXAMINER
5/15/02